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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/803,015	03/17/2004	Kimihiro Kikuchi	9281-4762	5124

7590 10/09/2008
Brinks Hofer Gilson & Lione
P.O. Box 10395
Chicago, IL 60610

EXAMINER

LAZORCIK, JASON L

ART UNIT	PAPER NUMBER
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1791

MAIL DATE	DELIVERY MODE
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10/09/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<p align="center">Advisory Action Before the Filing of an Appeal Brief</p>	<p>Application No. 10/803,015</p>	<p>Applicant(s) KIKUCHI, KIMIHIRO</p>	
	<p>Examiner JASON L. LAZORCIK</p>	<p>Art Unit 1791</p>	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 04 September 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1-4, 6-9, and 11-22.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

/Steven P. Griffin/
Supervisory Patent Examiner, Art Unit 1791

Continuation of 11. does NOT place the application in condition for allowance because:

Applicant's arguments, filed September 4, 2008, with respect to the rejection of claims presented in the Official Action dated June 18, 2008 have been fully considered and are persuasive in part. The rejection of claims under 35 U.S.C. §102(b) over Bartman has been withdrawn. The rejection of claims under 35 U.S.C. §103(a) over Bartman and Demeritt are maintained.

With respect to the rejection of claim 1 and dependents in view of the Bartman reference, Applicant alleges that, in contrast to the requirement of claim 1, the Bartman cylindrical holder is not formed in an integrated form with a void part. In support of this position, Applicant notes that the Bartman holder comprises two portions, an inner ring 5 and an outer ring 7, and that the relative position of these rings changes during the molding process. Applicant thereby concludes that the Bartman form is not integrated.

The Examiner disagrees with the basis for Applicants argument.

With respect to this matter, the Examiner does not contest that the original cylindrical holder body of the Bartman reference is comprised of two portions. However, Applicant will appreciate, particularly from the excerpt figures 2, 5, and 6 presented on page 6 of the March 14 Official Action, that the body resulting from disclosed process would indeed be construed by one of ordinary skill as a unitary body "formed in an integrated form".

Although Applicant appears to argue that the cylindrical holder itself is formed of a single part or a unitary body prior to the molding operation, such a limitation is nowhere reflected in the pending claims. It follows, in response to Applicant's argument that the references fail to show certain features of applicant's invention, that the features upon which applicant relies are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicants' arguments regarding the extra volume of optical element material in relation to the volume of the void part are acknowledged. Applicant has been previously advised of the Examiners position this matter particularly on pages 7-8 and pages 10-11 for claim rejections based on Bartman and Demeritt, respectively.

Rejection of Claims under 35 USC §102(b) over Bartman are Convincing:

Applicant acknowledges that Bartman teaches "providing an overdimension volume of material", but argues that the reference does not limit the amount of material in the manner presently claimed. Applicant concludes that the Bartman reference can not anticipate the claimed invention. Applicants arguments on this matter are persuasive and the rejection of claims under 35 U.S.C. §102(b) over Bartman is hereby withdrawn.

Rejection of Claims Under 35 USC §103(a) over Bartman or Demeritt are Maintained

For the reasons noted above on indicated pages 7-8 and 10-11, the obviousness rejections in view of the Bartman and Demeritt references are maintained.

Applicant was previously advised that one of ordinary skill in the arts would reasonably be expected to tailor the volume of starting material as a routine quality control measure. Applicant was further advised that the preferred conditions, namely a optical material excess volume smaller than the void volume, would predictably result in a enhanced pressing reproducibility and that Applicants conditions would have reasonably been derived through no more than routine experimentation and optimization over the prior art disclosed processes. Applicant has failed to provide a convincing rebuttal to the Examiners stated position and it follows that Applicants' arguments on this matter are held to be unpersuasive in view of the ordinary level of skill in the engineering arts at the time of the invention..